



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,076	09/30/2003	Jeyhan Karaoguz	14275US02	5075

23446 7590 12/22/2006
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

FRINK, JOHN MOORE

ART UNIT	PAPER NUMBER
----------	--------------

2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

24

Office Action Summary	Application No. 10/675,076	Applicant(s) KARAOGUZ ET AL.	
	Examiner John M. Frink	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that a proper search of the prior art cannot be made. For example: television, beginning on page 5, is described as having the ability to “utilize or arrange the delivery of media to [a] media peripheral” and further mentions the television “retriev[ing] stored media and transfer[ing] the stored media.” Currently one of ordinary skill in the art would not describe a television as a device that either generates commands or controls media transfers from one physical location to another, but instead would describe a television in terms more consistent with wordnet.princeton.edu’s definition, which is “an electronic device that receives television signals and displays them on a screen.”

For the remainder of this application, the use of the term “television” is interpreted to be equivalent to the “media processing system” described in Figure 1.

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “television” in claims 1, 2, 4, 8, 9, 11, 12, 14, 18, 19, 21 – 24, and 27 - 30 is used by the claim to mean a device capable of “controlling devices . . . and generating at least one command that causes the delivery of media” and further “controlling the delivery of the media” (pg. 4 and 5), while the accepted meaning is “an electronic device that receives television signals and displays them on a screen” (as defined by wordnet.princeton.edu). The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 2112

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 – 30 are rejected under 35 U.S.C. 102(a) and 35 U.S.C. 102(b) as being anticipated by SONICblue Incorporated (ReplayTV 4000 User Guide, 2001).

Regarding claim 1, SONICblue shows a method of controlling the communication of media from a television without consuming the media by said television, and transferring the media from a first location to at least a second location according to said controlling communication by the television (pg. 55). As this method is enabled by the SONICblue software, which comprises a computer program stored on a computer readable medium, claim 11 is inherently disclosed as well.

Regarding claim 21, the media peripheral and a television that is utilized to arrange media peripheral for playback on said media peripheral, along with communication pathway that operates independent of the television through which the media is delivered is also shown (pg. 55 and pg. 59 - 60).

Regarding claims 2, 3, 12, 13, 22 and 23, SONICblue further shows generating at least one command from said television causing said transfer of the media, as well as receiving at least one command that results in said transfer of media from said first to said second location (pg. 59 – 60).

Regarding claims 4, 5, 14 and 15, SONICblue further shows receiving at least one request by said television for said controlling communication of the media, that further results in said transfer of the media (pg. 59 - 60).

Regarding claims 6 and 16, SONICblue further shows where said first and said second location correspond to a location of at least one media peripheral, a media processing system a media storage system, a personal computer, and a third party media provider (pg. 55).

Regarding claims 7 and 17, SONICblue further shows where said first location and said second location is at least one of co-located and remotely located (pg. 55 and pg. 59 – 60).

Regarding claims 8 and 18, SONICblue further shows displaying a user interface on a display of said television for said controlling communication of said transfer of media (pg. 57 and pg. 60).

Regarding claims 9 and 19, SONICblue further shows scheduling said transfer of media from said first location to at least a second location utilizing said television without consuming the media (pg. 22 and Chapter 5).

Regarding claim 10 and 20, SONICblue further shows storing said transferred media in at least one of said first location and said second location (Chapter 3, pg. 22 and pg. 55 and pg. 59 – 60).

Regarding claim 24, SONICblue shows where said television displays a user interface that is utilized to control said media delivery (Chapter 3, pg. 20, pg. 25 and pg. 33, Chapter 5, pg. 57 and pg. 60).

Regarding claim 25, SONICblue shows where said user interface provides an indication of said media peripheral (Chapter 1, pg. 5, Chapter 30, pg. 20, pg. 35 ('Recording dots' side box), Chapter 5, pg. 57).

Regarding claim 26, SONICblue shows where upon selection of said media peripheral in said user interface, said media delivery is initiated (Chapter 3, pg. 25 – 27, Chapter 5, pg. 60).

Regarding claim 27, SONICblue shows a system supporting communication of media, the system comprising a media peripheral located at a first home and a television located at a second home, wherein said television is utilized to arrange delivery of media to said media peripheral (Chapter 5, pg. 57 – 61).

Regarding claim 28, SONICblue shows where said television retrieves stored media and transfers said stored media to at least one of a media peripheral located at a first home and a media peripheral remotely located with respect to said first home (Chapter 5, pg. 57 – 61).

Regarding claim 29, SONICblue shows where said television schedules said delivery of media to said media peripheral (Chapter 5, pg. 57 – 62).

Regarding claim 30, SONICblue shows where said television redirects delivery of media to said media peripheral without said television at least one of receiving and consuming the media (Chapter 5, pg. 57 – 62).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571)272-

9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven McAllister can be reached on (571)272-6785. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Frink


STEVE MCALLISTER
SUPERVISORY PATENT EXAMINER